Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte
HARIKLIA DRIS REITZ,
NOBUYUKI KAMBE,
SUJEET KUMAR
and XIANGXIN BI

Appeal No. 2002-0227
Application No. 09/433,202

ON BRIEF

Before GARRIS, LIEBERMAN and POTEATE , Administrative Patent Judges.

LIEBERMAN, Administrative Patent Judge.

REMAND TO THE EXAMINER

On consideration of the record, we find that this case is not ready for appeal and thus, we remand the application to the examiner for appropriate action.

The examiner has rejected the pertinent appealed claims as follows:

Claims 1 through 28 and 31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Rostoker in view of Ishitobi and Farkas.[1] The final rejection however contained four separate and distinct rejections on the grounds of obviousness-type double patenting. In the appeal before us, "[i]t is the examiner's position that provisional obvious double patenting rejections are not appealable because the applications have not issued as patent." See Answer, page 8. This position is in error.

It is well accepted that it is within the jurisdiction of this Board to review and decide issues directed to provisional rejections including those rejections on the grounds of double patenting. See *In re Wetterau*, 356 F.2d 556, 557-58, 148 USPQ 499, 501 (CCPA 1966); *Ex parte Karol*, 8 USPQ2d 1771, 1773-74 (Bd. Pat. App. & Int. 1988); Ex parte DesOrmeaux 25 USPQ2d 2040, 2044 (CAFC, 1992). See note 9.

Accordingly, the examiner's position with respect to the merits of the obviousness-type double patenting rejection is not before us for consideration. Therefore, the subject

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[1]The following rejections have been withdrawn:
1. The rejection of claim 27 under 35 USC § 112, second paragraph as indefinite.
2. The rejection of claims 1 through 28 and 31 under 35 USC § 103(a) as unpatentable over Ishitobi alone or in view of Farkas, Grover alone or in view of Farkas, or Kaufman alone or in view of Farkas.
3. The rejection of claims 1 through 28 and 31 under 35 USC § 103(a) as unpatentable over Miyashita in view of Farkas or Brancaleoni in view of Farkas.
4. The rejection of claims 1 through 4, 7 through 28 and 31 under 35 USC § 103(a) as unpatentable over Picardi in view of Ishitobi and Farkas, Hirabayashi in view of Ishitobi and Farkas or Sasaki in view of Ishitobi and Farkas.
5. The rejection of claims 1 through 28 and 31 as unpatentable over Atsugi in view of Ishitobi and Farkas.
6. Claims 1 through 4, 7 through 18, 23 through 28 and 31 under 35 USC § 103(a) as unpatentable over Haisma in view of Ishitobi and Farkas.

See Answer, page 7 and Final Rejection, pages 2 and 3.

application is being returned to the jurisdiction of the examiner for a response limited to the examiner's position on the merits of the obviousness-type double patenting rejections with respect to each of the four separate double patenting rejections.

With respect to each of the aforesaid rejections, the examiner should consider that Application Serial Number 08/961,735 has matured into U. S. Patent Number 6,290,735. The examiner should further consider the appellants' statement that, "Applicants have filed herewith a terminal disclaimer over copending Applications 09/085,514 and 09/136,483 to obviate the double patenting rejections over these two copending applications," and consider the sufficiency of the terminal disclaimers with respect to each of the rejections.

The examiner is further directed to issue a Supplemental Examiner's Answer directed to the double patenting rejections now present in the record before us. A Supplemental Examiner's Answer should include a complete statement of the examiner's views with regard to each of the double patenting rejections and the appellants' remarks related thereto as they appear in the Brief and Reply Brief.

APPROPRIATE ACTION

We remand this application to the examiner for action consistent with the above.

As a final point, we emphasize that we have not considered the merits of any of the examiner's rejections. We will do so when the application is in condition for a decision on appeal.

This application, by virtue of its "special" status requires an immediate action. MPEP § 708.01 (8th ed., Rev. 1 Feb. 2003). It is important that the Board be informed promptly of any action affecting the appeal in this case (e.g., abandonment, issue, reopening prosecution).

REMANDED

BRADLEY R. GARRIS
Administrative Patent Judge)
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PAUL LIEBERMAN) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES
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LINDA R. POTEATE)
Administrative Patent Judge)

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